

REMARKS

This communication responds to the Office Action mailed on November 18, 2004. Claim 13 is amended (for grammatical clarity and not for reasons related to patentability), no claims are canceled, and no claims are added. As a result, claims 1-25 are now pending in this Application. If the Examiner is not convinced that the pending claims are in condition for allowance after reviewing this document, the courtesy of an Examiner's Interview, to include one or more inventors, is respectfully requested prior to preparing and mailing any Final Office Action.

Submission of Formal Drawings

The Applicants submit herewith three (3) sheets of formal drawings. It is believed that the drawings are in compliance with 37 C.F.R. 1.84. No amendments to the drawings have been made.

§102 Rejection of the Claims

Claims 1-11, 14-16, and 18-21 were rejected under 35 USC § 102(e) as being anticipated by Kinnunen et al. (U.S. P.G. Pub. No. 2001/0018349; hereinafter "Kinnunen"). The Applicants do not admit that Kinnunen is prior art, and reserve the right to swear behind this reference at a later date. In addition, because the Applicants assert that the Office has not shown that Kinnunen discloses the identical invention as claimed, the Applicants respectfully traverse this rejection of the claims.

It is respectfully noted that anticipation under 35 USC § 102 requires the disclosure in a single prior art reference of each element of the claim under consideration. *See Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, "[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

With respect to independent claims 1 and 10, it is respectfully noted that Kinnunen is directed toward a service-discovery system based on advertising available services to potential users. See Kinnunen, Paras. 73-74. User profiles may be used to direct particular services to targeted users, since the mobile users “do not necessarily know which services are available at a particular location.” Kinnunen, Para. 76. “Therefore, the user characteristics are examined and suitable services are targeted at them.” *Id.* Thus, while the assertion is made in the Office Action that Kinnunen discloses various elements of the claims, it is respectfully noted that Kinnunen typically operates as part of a service advertising environment, rather than a query-based environment. See Kinnunen, FIGs. 3 and 4, “notifications” element. For example, a set of services may be automatically published to the user, and then selected by the user via subscription. See Kinnunen, Paras. 101-102.

It is admitted in the Office Action that Kinnunen operates by “[r]eceiving service queries from the mobile terminals subsequently [sic] obtaining the location information associated with the mobile terminal”. Office Action, Pg. 3, lines 12-14. This is in accordance with the order of operation described by Kinnunen: (1) when a mobile terminal or mobile entity [ME] 214 first connects to a network, a query including the user profile is sent to the network [Kinnunen, Para. 124]; (2) a location server 252 monitors the location of the ME 214 via a location agent 218 [Kinnunen, Paras. 110, 124]; (3) a service configurator 254 uses profile matching to create a view of currently available services for the user based on the monitored location and the previously-constructed profile [Kinnunen, Para. 125]; and (4) the user selects a service from those that are available [Kinnunen, Para. 102].

Thus, Kinnunen does not teach “a mobile device ... capable of sending *a query including a service location associated with the current location and at least one selected member of the list of preferred services to the service registry*,” as claimed by the Applicants. Rather, Kinnunen operates to track the mobile station location and to publish lists of location-available services prior to receiving a specific service request from the mobile station. This conclusion is reinforced by the Office Action admission that the “[s]ervice being selected by the user of the mobile terminal [is] from user pre-set service preferences.” Office Action, Pg. 3, lines 15-16.

Similar considerations apply to claim 14, which includes “sending a first *query including a service location ... and at least one selected member of a list of services ... to a service*

registry.” This type of operation is not taught by Kinnunen, which specifically notes that “[t]he location agent 218 provides location information concerning the location of the ME 214 with the query and it is received by the location server 252 ... [then] the service configurator 254 uses profile matching to create a service view of services applicable to this particular ME [by] looking at service profile ... information from the service repository 260”. See Kinnunen, Paras. 124-125.

It is respectfully noted that “The *identical invention* must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131 (emphasis added). Therefore, since what is disclosed by Kinnunen is not identical to the subject matter of the embodiments claimed, the rejection of independent claims 1, 10, and 14 (as well as claims 2-9, 11, 15-16, and 18-21 that depend from them) under § 102(e) is improper. Reconsideration and allowance is respectfully requested.

§103 Rejection of the Claims

Claims 12 and 17 were rejected under 35 USC § 103(a) as being unpatentable over Kinnunen in view of Chern et al. (U.S. 6,381,465; hereinafter “Chern”). Claim 13 was rejected under 35 USC § 103(a) as being unpatentable over Kinnunen in view of Stewart et al. (U.S. 6,414,635; hereinafter “Stewart”). Claims 22-24 were rejected under 35 USC § 103(a) as being unpatentable over Kinnunen in view of Purdani et al. (U.S. 6,556,824; hereinafter “Purdani”). Claim 25 was rejected under 35 USC § 103(a) as being unpatentable over Kinnunen in view of Purdani and further in view of Evans et al. (U.S. 6,327,535; hereinafter “Evans”). First, the Applicants do not admit that Chern, Stewart, Purdani, or Evans are prior art, and reserve the right to swear behind these references in the future. Second, since a *prima facie* case of obviousness has not been established as required by M.P.E.P. § 2142, the Applicants respectfully traverse this rejection. Third, since any claim that depends from a nonobvious base claim is also nonobvious under M.P.E.P. § 2143.03, all of the rejected claims are nonobvious.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d (BNA) 1596, 1598 (Fed. Cir. 1988). In combining prior art references to construct a *prima facie* case, the Examiner must show some

objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art that would lead an individual to combine the relevant teaching of the references. *Id.*

The M.P.E.P. contains explicit direction to the Examiner that agrees with the *In re Fine* court:

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d (BNA) 1438 (Fed. Cir. 1991)).

While it is not necessary that the cited references or prior art specifically suggest making the combination, there must be some teaching somewhere which provides the suggestion or motivation to combine prior art teachings and applies that combination to solve the same or similar problem which the claimed invention addresses. One of ordinary skill in the art will be presumed to know of any such teaching. (See, e.g., *In re Nilssen*, 851 F.2d 1401, 1403, 7 U.S.P.Q.2d (BNA) 1500, 1502 (Fed. Cir. 1988) and *In re Wood*, 599 F.2d 1032, 1037, 202 U.S.P.Q. (BNA) 171, 174 (C.C.P.A. 1979)). The requirement of a suggestion or motivation to combine references in a *prima facie* case of obviousness is emphasized in the Federal Circuit opinion, *In re Sang Su Lee*, 277 F.3d 1338; 61 U.S.P.Q.2D 1430 (Fed. Cir. 2002), which indicates that the motivation must be supported by evidence in the record.

No proper *prima facie* case of obviousness has been established because (1) combining the references does not teach all of the limitations set forth in the claims, (2) there is no motivation to combine the references, and (3) combining the references provides no reasonable expectation of success. Each of these points will be explained in detail, as follows.

Combining References Does Not Teach All Limitations: As noted above, Kinnunen does not teach the elements of “a mobile device ... capable of sending a query including a service location associated with the current location and at least one selected member of the list of preferred services to the service registry,” or “sending a first query including a service location ... and at least one selected member of a list of services ... to a service registry.” as claimed in independent claims 10 and 14 (as well as in dependent claims 12-13, 17, and 22-25).

Neither Chern, Stewart, Purdani, nor Evans do anything to supply this deficiency. Thus, no combination of the cited references can provide this claimed limitation. In addition, it is respectfully noted that if an independent claim (i.e., claims 10 and 14) is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom (i.e., claims 12-13, 17, and 22-25) is also nonobvious. See M.P.E.P. § 2143.03.

No Motivation to Combine References: With respect to claims 12 and 17, it is admitted in the Office Action that Kinnunen “fail[s] to clearly specify said mobile device comprising: a timer ... for determining a service query update interval (claim 12) and further including: determining that a polling interval time period has ended (claim 17).” It is respectfully noted that Kinnunen teaches away from using a timer, since Kinnunen’s service updates are automatic and aperiodic, as needed, based on: ME location changes, service additions over time, and service deletions over time. See Kinnunen, Paras. 128-132. Thus, it appears the Examiner is using personal knowledge in making the statement that “it would have been obvious to have Kinnunen et al. mobile device/element ... include periodic updated services as taught by Chern et al. for the purpose of providing services as the user dynamically varies its position.” This use of an unsupported assertion in the Office Action does not satisfy the explicit requirements needed for demonstrating motivation as set forth by the *In re Sang Su Lee* court, and the Examiner is therefore respectfully requested to submit an affidavit as required by 37 C.F.R. § 1.104(d)(2).

With respect to claim 13, it is admitted in the Office Action that Kinnunen “fail[s] to clearly specify said mobile device further comprising: a comparator ... for determining whether a selected number of services are available for binding to the mobile device.” It is respectfully noted that Kinnunen teaches away from using a comparator, since Kinnunen’s service updates are automatic, based on the user profile comparisons and available services. See Kinnunen, Para. 126. Thus, it appears the Examiner is using personal knowledge in making the statement that “it would have been obvious to have Kinnunen et al. system for providing location dependent services ... as taught by Stewart et al. for the purpose of intelligently tailor [sic] services to user by finding alternative services that appropriately match an [sic] specific user preference.” This use of an unsupported assertion in the Office Action does not satisfy the explicit requirements needed for demonstrating motivation as set forth by the *In re Sang Su Lee* court, and the

Examiner is therefore respectfully requested to submit an affidavit as required by 37 C.F.R. § 1.104(d)(2).

With respect to claims 22-24, it should be noted that Purdani states the "... existing requirement to provide service renegotiation when a desired QoS [quality of service] parameter cannot be ... maintained is therefore a disadvantageous use of the system resources." Purdani, Col. 2, lines 55-58. Purdani goes on to note that communications should continue in the face of degraded QoS levels "without the need for control signaling with the mobile station and within the infrastructure to renegotiate service quality levels." Purdani, Col. 3, lines 25-31. Thus, Purdani teaches away from the claimed activity of binding alternative services based on degradation of QoS (Application, claims 22-24). Therefore, it appears the Examiner is using personal knowledge in making the statement that "it would have been obvious ... to have Kinnunen ... method ... for providing location dependent services to a mobile terminal to quality level parameters associated with a service as taught by Purdani ... for the purpose [sic] ensuring appropriate communication quality levels." This use of an unsupported assertion in the Office Action does not satisfy the explicit requirements needed for demonstrating motivation as set forth by the *In re Sang Su Lee* court, and the Examiner is therefore respectfully requested to submit an affidavit as required by 37 C.F.R. § 1.104(d)(2).

With respect to claim 25, and as noted in the previous paragraph, Purdani teaches away from binding alternative services bases on QoS degradation, as claimed by the Applicants in claims 22-25. Thus, it appears the Examiner is again using personal knowledge in making the statement that "it would have been obvious ... to have Kinnunen ... in view of Purdani ... method ... for providing location dependent services according to quality level parameters to retrieve quality information from service providers as taught by Evans ... for the purpose of accurately monitoring the quality of service of a ... service provider." This use of an unsupported assertion in the Office Action does not satisfy the explicit requirements needed for demonstrating motivation as set forth by the *In re Sang Su Lee* court, and the Examiner is therefore again respectfully requested to submit an affidavit as required by 37 C.F.R. § 1.104(d)(2).

The test for obviousness under § 103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements

that define the invention. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985). References must be considered in their entirety, including parts that teach away from the claims. See M.P.E.P. § 2141.02. The fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01.

No Reasonable Expectation of Success: As noted previously, providing periodic service updates to Kinnunen via the timer of Chern merely adds an unnecessary activity to the operation of Kinnunen's system (where updates are automatic, aperiodic, and occur on an as-needed basis). The same automatic update capability applies to available services, obviating the need for combination with Stewart. Finally, binding alternative services based on degradation of QoS as claimed by the Applicants defeats the explicit operational preference of Purdani. Thus, the suggested alterations do not meet the standard of "a reasonable expectation of success" required by M.P.E.P. § 2142. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed invention. *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984), and M.P.E.P. § 2143.01.

Therefore, since there is no evidence in the record to support adding Chern's periodic service polling or Stewart's revised service selection to the automatic service provision of Kinnunen, since Purdani teaches away from combination with Kinnunen with respect to providing the claimed embodiments, and since no reasonable expectation of success arises, a *prima facie* case of obviousness has not been established with respect to claims 12-13, 17, and 22-25. It is therefore respectfully requested that the rejection of claims 12-13, 17, and 22-25 under 35 U.S.C. § 103 be reconsidered and withdrawn.

CONCLUSION

The Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. As noted above, if the Examiner is not convinced that all of the pending claims are in condition for allowance after reviewing this document, the courtesy of an Examiner's Interview is respectfully requested prior to preparing and mailing any Final Office Action.

The Examiner is invited to telephone the Applicant's attorney, Mark Muller at (210) 308-5677, or Applicants' below-named attorney at (612) 349-9592 to facilitate prosecution of this application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 18 day January 2005.

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